

REMARKS

In the Office Action of December 20, 2004,¹ claims 33 and 58 were rejected under 35 U.S.C. § 102(b) as anticipated by *Apple Corps*; claims 1-8, 10, 17, 20, 23-27, 29, 31-41, 43, 48, 51, and 53-58 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,571,003 to *Hillebrand et al.* ("*Hillebrand*"); claims 1-58 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,283,858 to *Hayes, Jr. et al.* ("*Hayes*"); and claims 1-32 and 34-57 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Application Publication No. 2002/0064302 to *Massengill* ("*Massengill*"). Claims 1-58 remain pending in this application, and Applicants address the rejections below.

Section 102(b) rejection of claims 33 and 58

Applicants traverse the rejection of claims 33 and 58 under 35 U.S.C. § 102(b) because *Apple Corps* fails to anticipate the claims.

Apple Corps relates to a game in which an apple, eyes, noses, eyeglasses, etc. can be manipulated for entertainment purposes. According to the Examiner, "the claims merely set forth a system comprising a processor" and "[t]he processor disclosed by *Apple Corps* is . . . capable of performing the method" (Office Action "OA" at 2). Applicants disagree with the Examiner.

Contrary to the Examiner's assertions, claims 33 and 58 do not merely recite "a system comprising a processor." Instead, claim 33 recites a system comprising a processor "configured to perform the method of claim 1." Claim 33 thus requires a processor configured to perform all

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether or not any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

of the features of claim 1. Likewise, claim 58 recites a system comprising a processor “configured to perform the method of claim 34” and thus requires all of the features of claim 34.

Applicants call attention to M.P.E.P. § 608.01(n)(III), which states:

[A] . . . dependent claim is directed to a combination including everything recited in the base claim and what is recited in the dependent claim. It is this combination that must be compared with the prior art, exactly as if it were presented as one independent claim.

The Examiner must compare claims 1 and 33 with the prior art exactly as if they were presented as one independent claim. Similarly, the Examiner must compare claims 34 and 58 with the prior art exactly as if they were presented as one independent claim.

Apple Corps does not teach each and every feature of claim 1 or claim 34. Indeed, claims 1 and 34 are not rejected in view of *Apple Corps*. Because *Apple Corps* fails to anticipate claims 1 and 34, the reference cannot anticipate dependent claims 33 and 58, which include all of the features of claims 1 and 34, respectively.

In rejecting claims 33 and 58, the Examiner alleged that the term “configured to” means “capable of” (OA at 4). The Examiner also alleged that *Apple Corps* discloses a processor “capable of performing the functions as set forth” (OA at 2, 4). Applicants disagree with the Examiner. To begin with, the term “configured to” specifies the configuration of the claimed processor and does not merely mean “capable of.” Further, even if *Apple Corps* were construed as disclosing a processor capable of performing a method, the reference does not disclose that the processor is capable of performing either the method recited in claim 1 or the method recited in claim 34. In fact, the Examiner provides no evidence, beyond pure conjecture, showing that *Apple Corps*’ alleged processor is capable of performing the “functions as set forth.” Indeed, *Apple Corps* does not teach a system comprising a processor with a configuration to perform either the method recited in claim 1 or that in claim 34. Because *Apple Corps* does not teach

each and every element of claims 33 and 58, as a matter of law, it cannot anticipate those claims. As such, the § 102 rejection of claims 33 and 58 based on *Apple Corps* should be withdrawn.

Section 103(a) rejection based on *Hillebrand*

Applicants traverse the rejection of claims 1-8, 10, 17, 20, 23-27, 29, 31-41, 43, 48, 51, and 53-58 under 35 U.S.C. § 103(a) because a case for *prima facie* obviousness has not been established. To establish *prima facie* obviousness under § 103(a), three requirements must be met. First, the applied references, taken alone or in combination, must teach or suggest each and every element recited in the claims. *See* M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the reference(s) or in the knowledge generally available to one of ordinary skill in the art, to combine or modify the reference(s) in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” M.P.E.P. § 2143 (8th ed. 2001).

Hillebrand is directed to a skin imaging analysis system (col. 1, lines 1-15; Abstract). In *Hillebrand*’s system, a picture of a person’s face is taken and then digitized to generate a digital image (col. 5, lines 5-9). Sub-images (e.g., Fig. 11, item 704) upon which analyses are performed are then determined from the digital image (col. 6, lines 16-18). According to *Hillebrand*, the sub-image determination process may involve excluding consideration of certain features, such as the eyes and nose, from the analysis (col. 6, lines 12-24). Analyses are performed on the sub-images to determine defects and results are displayed (*see* Fig. 3). *Hillebrand* discloses that “[o]nce the analysis results are displayed, the controller 200 and the display 108 may generate a simulated image showing an improvement and/or worsening to the defect areas” (col. 11, lines 45-50; *see* Fig. 3, step 310).

With regard to independent claim 1, *Hillebrand* does not teach or suggest the “simulated facial image” features. Indeed, the Examiner conceded that *Hillebrand* “fails to disclose the use of a simulated image as the initial image provided” (OA at 2).

In rejecting claim 1, the Examiner alleged that “[i]n the absence of any showing of criticality or unexpected results, the use of a simulated image . . . or a real image . . . taken from a photograph would have been an obvious design choice” (OA at 2-3). The Examiner further alleged that the “use of simulated images are old and well known as disclosed by applicant . . . and would be advantageous in that no imaging equipment would be [needed] to provide the initial image” (OA at 3). The Examiner has not established *prima facie* obviousness.

Applicants point out that determinations of obviousness must be supported by evidence on the record. See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (finding that the factual determinations central to the issue of patentability, including conclusions of obviousness by the Board, must be supported by “substantial evidence”). Further, the desire to combine or modify references must be proved with “substantial evidence” that is a result of a “thorough and searching” factual inquiry. See *In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52).

The Office Action fails to show that a skilled artisan considering *Hillebrand*, and not having the benefit of Applicants’ disclosure, would have modified the reference to include the “simulated facial image” features of claims 1 and 34. The Examiner’s statement that “use of a simulated image would be advantageous in that no imaging equipment would be [needed] to provide the initial image” is not supported and does not show a motivation or suggestion for modifying *Hillebrand*. As M.P.E.P. § 2143.01 makes clear, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art

also suggests the desirability of the combination” (citations omitted). The Office Action does not show that *Hillebrand* “suggests the desirability” of a modification resulting in the combination of elements recited in claims 1 and 34. For example, the Office Action does not show that *Hillebrand* suggests the desirability of eliminating the imaging equipment and using simulated images.

Further, the Office Action fails to show how simulated images would be used in *Hillebrand*’s system. The Examiner alleged that “one could merely use the computer that is already being used” (OA at 3). The Office Action, however, provides no evidence or reasoning to support that allegation. For example, the Office Action provides no evidence or reasoning showing that *Hillebrand*’s computing system would be capable of providing a simulated image as the “initial image” or showing a desire to modify *Hillebrand*’s system to perform such functionality. Although *Hillebrand* mentions using a controller (200) in a computing device to simulate improvements and worsening of defects, the Examiner does not establish that the controller would also enable a user to construct a simulated image as the “initial image” without modification. Applicants submit that the conclusions of obviousness in the Office Action were not reached based on facts gleaned from the cited references and that, instead, Applicants’ claims were improperly used in hindsight to reconstruct the prior art.

The Examiner alleged that “[t]he use of simulated images are old and well known as disclosed by applicant on page 9 of specification” (OA at 3). This allegation does not establish that the features of claim 1 would have been obvious. Applicants call attention to M.P.E.P. § 2141.02, which makes clear that “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious (internal

citations omitted). Even if “simulated images” were obvious or well known, the Examiner failed to establish that claim 1 as a whole, including “enabling an individual to construct a simulated facial image using a facial construction computer program, the facial construction computer program permitting the individual to select at least one of a head, eyes, nose, lips, ears, and eyebrows,” would have been obvious.

Although the specification states that facial construction computer programs are used in various applications, the specification in no way indicates that “a method of enabling simulated use of a cosmetic product on a simulated facial image” including “enabling an individual to construct a simulated facial image using a facial construction computer program, the facial construction computer program permitting the individual to select at least one of a head, eyes, nose, lips, ears, and eyebrows” was well known.

Furthermore, to the extent the Examiner is taking Official Notice that the use of simulated images in the manner recited in the claims was well known, Applicants call attention to the provisions of M.P.E.P. § 2144.03, the procedures set forth in the Memorandum by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy dated February 21, 2002, and the precedents provided in *Dickinson v. Zurko*, 527 U.S. 150, 50 U.S.P.Q.2d 1930 (1999) and *In re Ahlert*, 424 F.2d, 1088, 1091, 165 U.S.P.Q. 418, 420 (CCPA 1970). An Official Notice rejection is improper unless the facts asserted are well-known or common knowledge in the art, and capable of instant and unquestionable demonstration as being well-known. Further, any facts asserted as well-known should serve only to “fill in the gaps” in an insubstantial manner. It is never appropriate to rely solely on “common knowledge” without evidentiary support in the record as the principal evidence upon which a rejection is based. Applicants submit that using a

simulated image in the manner recited in claim 1 was not unquestionably well-known and that the Office Action has failed to demonstrate the contrary.

As M.P.E.P. § 2144.03 makes clear, with regard to Official Notice, “[t]he standard of review applied to findings of fact is the “substantial evidence” standard under the Administrative Procedure Act (APA)” (citations omitted). M.P.E.P. § 2144.03 points out that “an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support” (citations omitted). The Office Action does not provide substantial evidence on the record to show that the features of Applicants’ claims involving a “simulated facial image” were unquestionably well-known.

Applicants therefore expressly traverse any taking of Official Notice that the features of claim 1 involving a “simulated facial image” were well known, and Applicants request that the Examiner either cite a competent prior art reference in substantiation of such a conclusion, or else withdraw the rejection. To the extent the Examiner relies on personal knowledge to allege that certain claim features were well known, Applicants request that the Examiner provide an affidavit evidencing such knowledge as factually based and legally competent to support the Examiner’s conclusions. *See* M.P.E.P. § 2144.03.

For at least the foregoing reasons, the Examiner failed to meet the burden of supporting a *prima facie* conclusion of obviousness. In alleging that criticality or unexpected results have not been shown (OA at 3), the Examiner is improperly attempting to shift the burden of establishing a *prima facie* case of unpatentability. As M.P.E.P. § 2142 makes clear, “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness [and] . . . [i]f the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.” The Examiner failed to meet the burden of showing *prima facie*

obviousness and, as such, the § 103 rejection should be withdrawn regardless of whether Applicants show criticality or unexpected results.

For at least the reasons advanced above, the § 103(a) rejection of claim 1 should be withdrawn. Although of different scope than claim 1, independent claim 34 recites “simulated facial image” features similar to those of claim 1 noted above. The § 103(a) rejection of claim 34 should be withdrawn for at least reasons similar to those presented above in connection with claim 1. The rejection of claims 2-8, 10, 17, 20, 23-27, 29, 31-33, 35-41, 43, 48, 51, and 53-58 should be withdrawn as well, at least because of the respective dependence of those claims upon claims 1 and 34. Applicants thus request withdrawal of the § 103(a) rejection and the timely allowance of claims 1-8, 10, 17, 20, 23-27, 29, 31-41, 43, 48, 51, and 53-58.

Section 103(a) rejection of claims 1-58 based on *Hayes*

Applicants traverse the rejection of claims 1-58 under 35 U.S.C. § 103(a) because a case for *prima facie* obviousness has not been established based on *Hayes*.

Hayes is directed to an “image processing system which allows manipulation of facial features” (col. 1, lines 10-15). In particular, *Hayes* is directed to “customizing video games” (col. 4, lines 17-65). With *Hayes*’s system, images related to a video game character are input to a digital computer, an image of a video game player is input to the computer, and the facial features of the video game character are replaced with the facial features of the player (col. 4, lines 17-65). In this fashion, the player can use his own image in the game, rather than the video game character’s. *Hayes* also discloses a “method for simulating cosmetic reconstruction” in which an image of a body portion is input to a computer and a modified image showing changes to the body portion (e.g., reconstruction of a nose) is generated (col. 13, lines 10-42; Fig. 22).

With regard to independent claim 1, *Hayes* does not teach or suggest at least “enabling an individual to construct a simulated facial image using a facial construction computer program,

the facial construction computer program permitting the individual to select at least one of a head, eyes, nose, lips, ears, and eyebrows,” as claimed. Although *Hayes* discloses inputting and manipulating images, it does not teach or suggest enabling an individual to construct a “simulated facial image” as recited in independent claim 1.

The Examiner conceded that *Hayes* does not “disclose how the initial image is obtained” (OA at 3). The Examiner, however, alleged that “[i]n the absence of any showing of criticality or unexpected results, the use of a simulated image . . . or a real image . . . taken from a photograph would have been an obvious design choice” (OA at 3). The Examiner further alleged that the “use of simulated images are old and well known as disclosed by applicant . . . and would be advantageous in that no imaging equipment would be [needed] to provide the initial image” (OA at 3). These allegations by the Examiner do not establish *prima facie* obviousness.

To begin with, the Examiner has not shown that a skilled artisan considering *Hayes*, and not having the benefit of Applicants’ disclosure, would have modified *Hayes* to include the “simulated facial image” features of claim 1. The statement that “use of a simulated image would be advantageous in that no imaging equipment would be [needed] to provide the initial image” does not show a motivation or suggestion for modifying *Hayes*. The Examiner does not show that *Hayes* suggests the desirability of eliminating imaging equipment and using simulated images. Further, the Examiner fails to show how simulated images would be used in *Hayes*’s system. Again, the Examiner alleged that “one could merely use the computer that is already being used” (OA at 3). The Examiner, however, provides no evidence or reasoning supporting that allegation. In addition, the Examiner does not provide a proper motivation from the knowledge generally available to one skilled in the art. The Examiner is improperly using Applicants’ claims in hindsight to reconstruct the prior art.

The Examiner also alleged that it would have been obvious “to have applied any known cosmetic changes to the patient and . . . to have [shown] . . . the facial changes in combination with images of the entire patient dressed in clothing in order to more completely assess the changes to the patient’s face” (OA at 3). These allegations are completely conclusory and unsupported by any evidence supplied by the Examiner. Further, the conclusory allegations do not establish that it would have been obvious to modify *Hayes* to perform the step of “enabling the individual to simulate use of the selected cosmetic product on the simulated facial image and to view on the display device an alteration of the simulated facial image having the simulated cosmetic product,” as recited in claim 1. These allegations in the Office Action do not provide a proper motivation for modifying *Hayes* to include the “simulated facial image” constructing features of claim 1.

Moreover, as explained above, Applicants’ specification in no way indicates that the features of claim 1 involving a “simulated facial image” were well known, and Applicants traverse any taking of Official Notice. The features of claim 1 involving a “simulated facial image” were not unquestionably well-known and the Office Action has failed to demonstrate the contrary. In addition, as noted above, M.P.E.P. § 2141.02 makes clear that “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious (internal citations omitted). Even if “simulated images” were obvious or well known, the Examiner failed to establish that claim 1 as a whole would have been obvious.

At least because the applied art fails to teach or suggest each and every element of claim 1 and the Examiner has failed to show that a skilled artisan would have modified the applied art

to include all of the claimed features, *prima facie* obviousness has not been established.

Because the Examiner failed to meet the initial burden of establishing *prima facie* obviousness, Applicants should not be required to show criticality or unexpected results.

For at least the reasons advanced above, the § 103(a) rejection of claim 1 based on *Hayes* should be withdrawn. Although independent claim 34 is of different scope than claim 1, the § 103(a) rejection of claim 34 based on *Hayes* should be withdrawn for at least reasons similar to those presented above in connection with claim 1. The rejection of claims 2-33 and 35-58 should be withdrawn as well, at least because of the respective dependence of those claims upon claims 1 and 34. Applicants thus request withdrawal of the § 103(a) rejection and the timely allowance of claims 1-58.

Section 103(a) rejection of claims 1-32 and 34-57 based on *Massengill*

Applicants traverse the rejection of claims 1-32 and 34-57 under 35 U.S.C. § 103(a) because a case for *prima facie* obviousness has not been established based on *Massengill*.

Massengill is directed to medical diagnostic tools (page 1, ¶ 0004). In particular, *Massengill* relates to an educational tool for a patient seeking plastic surgery. *Massengill* disclose that a patient's scanned photographs are properly sized and that a patient can perform "autosurgery" on himself by answering questions, such as "Is your nose too Small?" (page 3, ¶¶ 0028-0030). *Massengill* further discloses that, depending on the patient responses, a central computer programmed with software transmits an image of the desired effect (e.g., a new nose) to a remote site for display. (page 3, ¶ 0030).

With regard to independent claim 1, *Massengill* does not teach or suggest at least "enabling an individual to construct a simulated facial image using a facial construction computer program, the facial construction computer program permitting the individual to select at least one of a head, eyes, nose, lips, ears, and eyebrows," as claimed. Although *Massengill*

discloses scanning and transmitting various images, it does not teach or suggest enabling an individual to construct a “simulated facial image” as recited in independent claim 1.

The Examiner conceded that *Massengill* does not disclose “the use of a simulated facial image” (OA at 3). The Examiner, however, alleged that “[i]n the absence of any showing of criticality or unexpected results, the use of a simulated image . . . or a real image . . . taken from a photograph would have been an obvious design choice” (Office Action “OA” at 3). The Examiner has not established *prima facie* obviousness.

The Examiner has not shown that a skilled artisan considering *Massengill*, and not having the benefit of Applicants’ disclosure, would have modified the reference to include the “simulated facial image” features of claim 1. The statement that “use of a simulated image would be advantageous in that no imaging equipment would be [needed] to provide the initial image” does not show a motivation or suggestion for modifying *Massengill*. The Examiner does not show that *Massengill* suggests the desirability of eliminating imaging equipment and using simulated images. Further, the Examiner fails to show how simulated images would be used in *Massengill*’s system. Again, the Examiner alleged that “one could merely use the computer that is already being used” (OA at 4). The Examiner, however, provides no evidence or reasoning to support that allegation. In addition, the Examiner does not provide a proper motivation from the knowledge generally available to one skilled in the art. Rather, the Examiner again is improperly using Applicants’ claims in hindsight to reconstruct the prior art.

The Examiner further alleged that “the method of *Massengill* is applicable to all cosmetic areas of the body [and that] [t]he cosmetic product can be viewed to be the cosmetic surgical procedure” (OA at 4). The Examiner also alleged that it would have been obvious “to show the facial changes in combination with images of the entire patient dressed in clothing in order to

more completely assess the changes to the patient's face" (OA at 4). These additional allegations are completely conclusory and unsupported, and do not provide a motivation or suggestion for modifying *Massengill* to include the "simulated facial image" features of claim 1. These allegations in the Office Action do not establish that "enabling the individual to simulate use of the selected cosmetic product on the simulated facial image and to view on the display device an alteration of the simulated facial image having the simulated cosmetic product," as recited in claim 1, would have been obvious.

The Examiner alleged that "[t]he use of simulated images are old and well known as disclosed by applicant on page 9 of specification" (OA at 3). This allegation does not establish that the features of claim 1 would have been obvious. Even if "simulated images" were obvious or well known, the Examiner failed to establish that claim 1 as a whole would have been obvious. As explained, the specification in no way indicates that the features of claim 1 were well known. Further, Applicants traverse any taking of Official Notice that the features of claim 1 were well known. The "simulated facial image" features of claim 1 were not unquestionably well-known and the Office Action has failed to demonstrate the contrary.

For at least the foregoing reasons, *prima facie* obviousness has not been established with respect to independent claim 1. Because the Examiner has not met the initial burden of establishing *prima facie* obviousness, Applicants should not be required to show criticality or unexpected results. Accordingly, the § 103(a) rejection of claim 1 based on *Massengill* should be withdrawn. Although independent claim 34 is of different scope than claim 1, the § 103(a) rejection of claim 34 based on *Massengill* should be withdrawn for at least reasons similar to those presented above in connection with claim 1. The rejection of claims 2-32 and 35-57 should be withdrawn as well, at least because of the respective dependence of those claims upon

claims 1 and 34. Applicants thus request withdrawal of the § 103(a) rejection and the timely allowance of claims 1-58.

Conclusion


Applicants request the Examiner's reconsideration of the application in view of the foregoing, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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